

RECEIVED
CENTRAL FAX CENTER
NOV 30 2009

Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b) (Large Entity)					Docket No. 0109.03	
In Re Application Of: Dong et al.						
Application No. 10/797,346	Filing Date 03/10/2004	Examiner W. Haas	Customer No. 25278	Group Art Unit 1661	Confirmation No. 4296	
Invention: Transformation Methods for Guayle Using Agrobacterium and Reduced Light to Slow Metabolism and Enhance Recovery						
<u>Attention: Office of Petitions</u> <u>Mail Stop Petition</u> <u>COMMISSIONER FOR PATENTS</u> <u>P.O. Box 1450</u> <u>Alexandria, VA 22313-1450</u>						
<p>NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.</p> <p>The above-identified application became abandoned for failure to file a timely and proper response to a notice or action by the Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extension of time actually obtained.</p> <p style="text-align: center;">APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION</p> <p>NOTE: A grantable petition requires the following items:</p> <ul style="list-style-type: none"> (1) Petition fee; (2) Reply and/or issue fee; (3) Terminal disclaimer with disclaimer fee—required for all utility and plant applications filed before June 8, 1995; and for all design applications; and (4) Statement that the entire delay was unintentional. <p>1. <input checked="" type="checkbox"/> A proposed reply to the above-identified notice or action:</p> <p style="margin-left: 40px;"><input checked="" type="checkbox"/> is enclosed. <input type="checkbox"/> was filed on _____</p> <p style="margin-left: 40px;">The proposed reply is in the form of: _____</p> <p>2. <input type="checkbox"/> The issue fee:</p> <p style="margin-left: 40px;"><input type="checkbox"/> is enclosed. <input type="checkbox"/> was paid on _____</p> <p style="margin-left: 40px;">12/01/2009 HMARZ11 00000048 502135 10797346 01 FC:1453 1620.00 DA</p> <p>3. <input checked="" type="checkbox"/> The abandoned application was a:</p> <p style="margin-left: 40px;"><input type="checkbox"/> design application. <input checked="" type="checkbox"/> utility application. <input type="checkbox"/> plant application.</p> <p>4. <input type="checkbox"/> A terminal disclaimer (and fee) disclaiming a period equivalent to the period of abandonment is enclosed.</p> <p>5. <input checked="" type="checkbox"/> Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.</p>						

**Petition For Revival Of An Application For Patent Abandoned
Unintentionally Under 37 CFR 1.137(b) (Large Entity)**Docket No.
0109.03

In Re Application Of: Dong et al.

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/797,346	03/10/2004	W. Haas	25278	1661	4296

Invention: Transformation Methods for Guayle Using Agrobacterium and Reduced Light to Slow Metabolism and Enhance Recovery

Calculation and Payment of Fees

Enclosed are the following fees:


- | | |
|--|-----------------------------|
| 6. <input checked="" type="checkbox"/> Petition fee under 37 CFR 1.17(m) in the amount of: | <u>\$1,620.00</u> |
| 7. <input type="checkbox"/> Fee for reply in the amount of: | <u> </u> |
| 8. <input type="checkbox"/> Issue fee in the amount of: | <u> </u> |
| 9. <input type="checkbox"/> Continuing application filing fee in the amount of: | <u> </u> |
| 10. <input type="checkbox"/> Terminal disclaimer fee in the amount of: | <u> </u> |
| 11. <input type="checkbox"/> _____ | <u> </u> |
| Total fees enclosed: <u>\$1,620.00</u> | |

The fee of \$1,620 is to be paid as follows:

- ☐ A check in the amount of the fee is enclosed.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 50-2135
- ☐ Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

RECEIVED
CENTRAL FAX CENTER
NOV 30 2009

Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b) (Large Entity)					Docket No. 0109.03	
In Re Application Of: Dong et al.						
Application No. 10/797,346	Filing Date 03/10/2004	Examiner W. Haas	Customer No. 25278	Group Art Unit 1661	Confirmation No. 4296	
Invention: Transformation Methods for Guayle Using Agrobacterium and Reduced Light to Slow Metabolism and Enhance Recovery						
<p style="text-align: center;">Statement</p> <p>The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), Subsections (III)(C) and (D)).]</p> <p style="text-align: center;">WARNING:</p> <p>Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioner/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.</p> <div style="display: flex; justify-content: space-between; align-items: flex-end;"><div style="text-align: center;"> _____ <i>Signature</i></div><div style="text-align: right;">Dated: NOV. 30. 2009</div></div> <div style="border: 1px solid black; height: 150px; width: 350px; margin-left: auto; margin-top: 20px;"></div> <div style="margin-top: 20px;">cc:</div>						

**RECEIVED
CENTRAL FAX CENTER
NOV 30 2009**

PATENT
USDA Docket No.: 0109.03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Dong et al.

Application No.: 10/797,346

Filed: March 10, 2004

For: Transformation Methods for
Guayule Using Agrobacterium and
Reduced Light to Slow Metabolism and
Enhance Recovery

Customer No.: 25278

Confirmation No. 4296

Examiner: Wendy Haas

Technology Center/Art Unit: 1661

REVIVAL OF ABANDONMENT UNDER
37 CFR 1.137(b)

Assistant Commissioner for Patents
Office of the Director, Technology Center 1600
Washington, D.C. 20231

Sir:

In response to the abandonment mailed August 1, 2008 and the decision on the petition filed under 37 CFR 1.181(a)(2) requesting withdrawal of the holding of abandonment mailed 9/29/09, applicant requests a revival of abandonment of the instant application for being unintentionally abandoned under 37 CFR 1.137(b).

Remarks/Arguments begin on page 2 of this paper.

Appl. No. 10/797,346

PATENTRemarks:

Applicant submits that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. Applicant replied with a bona fide attempt to advance prosecution to the final action mailed January 11, 2008 on April 10, 2008. The final action did not contain any rejections; however, an objection to the claims was set forth. Applicant's response set forth a claim amendment to address the objection.

Applicant subsequently received a notice of abandonment, **without an advisory action** (PTOL-303), purportedly based on "Applicant's failure to timely file a proper reply to the Office letter on January 11, 2008....A proposed reply was received on April 10, 2008, but does not constitute a proper reply under 37 CFR 1.113(a) to the final rejection.". See attached PTOL 1432.

A proper reply under 37 CFR 1.113(a) consists of "(c)...cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.". As stated above, there were no outstanding rejections and the lone objection was complied with via submission of an amendment to address the objection. The amendment was based on a telephonic interview with the examiner wherein applicant submitted to the examiner's Rightfax no. (571)273-0976 (see attached fax log) a proposed amendment to remedy the objection so that the language was acceptable and better place the application in condition for allowance. The amendment submitted via Rightfax was the same as that presented officially in response to the final action.

Applicant asserts that the reply was in accordance with 37 CFR 1.113(a)(c) and that the examiner denied the amendment improperly or without merit. If the claim objections were properly treated as a matter of form and not substance (per MPEP 706.01), the final action was properly replied to. Moreover, if the claims were truly objected to, applicant should have been given the opportunity under 37 CFR 1.135 (c) to comply, without abandonment of the application.

Appl. No. 10/797,346

PATENT**Basis of objection/Reply to objection**

The examiner's objection to claims 1, 4 and 10 was based on "informalities" (see p. 2, line 1, "Claim objections of the final action"); however, the objection was practically treated by the examiner as a *defacto* rejection with the requirement that applicant include a "rooting step" to demonstrate that a plantlet formed.

MPEP 706.01 Contrasted With Objections [R-2] states "The refusal to grant claims because the subject matter as claimed is considered unpatentable is called a "rejection." The term "rejected" must be applied to such claims in the examiner's action. If the form of the claim (as distinguished from its substance) is improper, an "objection" is made." (Emphasis added)

The requirement that applicant include a "rooting" step, to distinguish a process step clearly was a matter of substance and not form. Assuming *arguendo* that the examiner asserts that the inclusion of rooting step was a matter of form, applicant's amendment to the claims explicitly including a rooting step should have satisfied the objection as a matter of form.

Applicant maintains that even in the absence of the amendment if the claims were to be viewed substantively, one of skill in the art would know from the state of the art and the instant specification that in order to form a plantlet, a rooting step is inherently present.

The inclusion of the rooting step in claims 1, 4 and 10 therefore complied with the objection set forth by the examiner. There were no other informalities presented by the examiner that applicant was required to address.

Neither an advisory action (PTOL- 303) nor explanation was given as to why the amendment to comply with the objection/informality was improper or incomplete.

Appl. No. 10/797,346

PATENT

Under 37 CFR 1.135 (c), "When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission."

Applicant's reply was a bona fide attempt to advance prosecution by inclusion of the rooting step in the amendment. If the examiner were properly treating the claims as objections (per MPEP 706.01) and still deemed the amended claim language as lacking some element of form, per 37 CFR 1.135(c) cited above, the more appropriate action should have been to afford applicant a new time period for reply for the inadvertent omission.

For the reasons cited above, applicant asserts that the abandonment was unintentional; moreover, that upon revival of the application per the arguments cited above, the amendment submitted April 10, 2008 should be entered or in accordance with 37 CFR 1.135 (c) applicant should be given the opportunity to comply with the objection or given a PTOL 303.

Appl. No. 10/797,346

PATENT

CONCLUSION

In view of the foregoing amendments, applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 510-559-5731.

Respectfully submitted,



Howard Owens
Reg. No. 58,219

USDA, ARS, OTT
800 Buchanan Street
Albany, California 94710
Tel: 510-559-5731
Fax: 510-559-5736